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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/743,758

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Jiro Kanamori

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EXAMINER

WEIER, ANTHONY J

ART UNIT

PAPER NUMBER

1761

MAIL DATE

DELIVERY MODE

06/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/743,758

Applicant(s)

KANAMORI ET AL.

Examiner

Anthony Weier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. This application contains claims of Group II drawn to an invention nonelected with traverse in the paper filed 8/28/06. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2-100647.

JP 2-100647 discloses a process wherein soy milk which comprises an emulsified mixture soy protein, soy fat, and water (inherently already emulsified naturally) and the addition of a coagulant in solution, wherein the coagulant is, for example, quick-acting magnesium chloride, to prepare a bean curd which is formed into a bag (i.e. pouch) and deep fried in oil (see Abstract, pages 239, 243, and 244).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2-100647.

JP 2-100647 is silent regarding the ratio of coagulant to soy protein as called for in instant claims 4. However, such determination would have been well within the purview of one having ordinary skill in the art at the time of the invention through routine experimental optimization as to the amount required to coagulate the material.

6. Claims 1-4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2-100647 taken together with JP 60-30659.

If it is shown that JP 2-100647 does not inherently provide for a soy milk containing fat, protein, and water that has been emulsified, the following should be noted. JP 60-30659 teaches the preparation of a bean curd having constant quality and good workability by first emulsifying soy milk so that "soybean protein and soybean fats contained are uniformly dispersed to give a soybean milk in a uniform colloidal state" wherein a "dispersant....of a stabilized aqueous solution of magnesium chloride...is added to the soybean milk". It would have been obvious to one having ordinary skill in the art at the time of the invention to have specifically employed this emulsifying step followed by a solution of coagulant for the advantages of the resulting bean curd as set forth therein.

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7. Claims 1-4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mother Earth News (1977 Article) taken together with JP 60-30659.

Mother Earth News discloses a process wherein tofu slices are deep-fried and cut to form pouches.

The claims call for the bean curd to be prepared from steps including emulsifying a soy protein, fat ingredient, and water, followed by addition of a solution of a coagulant (e.g. magnesium chloride). JP 60-30659 teaches the preparation of a bean curd having constant quality and good workability by first emulsifying soy milk so that "soybean protein and soybean fats contained are uniformly dispersed to give a soybean milk in a uniform colloidal state" wherein a "dispersant...of a stabilized aqueous solution of magnesium chloride...is added to the soybean milk". It would have been obvious to one having ordinary skill in the art at the time of the invention to have specifically employed this emulsifying step followed by a solution of coagulant for the advantages of the resulting bean curd as set forth therein.

JP 60-30659 is silent regarding the ratio of coagulant to soy protein as called for in instant claims 4. However, such determination would have been well within the purview of one having ordinary skill in the art at the time of the invention through routine experimental optimization as to the amount required to coagulate the material.

Response to Arguments

8. Applicant's arguments filed 3/1/07 have been fully considered but they are not persuasive.

Applicant argues that JP '647 does not disclose, teach, or suggest the step of emulsifying the soy milk as set forth in the instant claims. However, the soy milk of JP '647 has been naturally emulsified in situ, thus JP '647 discloses soy milk which has inherently been emulsified. Even though same have not been recited in the instant claims, it is expected that the product attributes Applicant describes (improved mouthfeel, avoidance of suwari, etc.) would be present in the product produced by the invention of JP '647 as JP '647 discloses the essential steps of the instant process as expressly articulated (e.g. emulsified components, addition of coagulant, etc.).

Applicant argues that the instant invention is a mass production process contrary to the invention of JP '647 which is described as being a conventional process. However, it should be noted that the instant claims express no steps that distinguish the instant invention as being mass produced rather than "conventionally" produced. Moreover, such terminology is relative. In particular, "conventionally" is relative as what is considered conventional to some at a particular time may not be to another at a different time. Likewise, the term "mass production", taken broadly, applies to the amount of material produced, and clearly, it would have obvious to have produced any number of units of soy milk by the process of JP '647 as a matter of preference. It appears that Applicant may also be arguing that the instant invention is a scaled up process compared to that of the primary reference. Nevertheless, absent a showing of unexpected results or unique processing steps, the concept of scale up of a process from lab to high production is notoriously well known, and it would have been obvious to one having ordinary skill in the art at the time of the invention to have expanded the

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production of a process as a matter of preference depending on, for example, consumer need.

Applicant argues that the processing steps of JP '659 are different from the Applicant's recited process and not applicable. However, JP '659 was applied for teaching the known concept of strongly stirring soybean milk (which contains soy protein, milk, and fats) and thus emulsifying same wherein such step provides a subsequent tofu product having constant quality and good workability and stability. In the event that it is convincingly shown that JP '647 itself does not teach the emulsifying step as called for in the instant claims, it would have been obvious to one having ordinary skill in the art at the time of the invention to have incorporated such step for such advantages taught by JP '659. Such motivation also applies to the addition of such emulsifying step to the process of Mother Earth News.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Weier whose telephone number is 571-272-1409. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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Anthony Weier
Primary Examiner
Art Unit 1761

Anthony Weier
May 25, 2007


5/25/07